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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,041	12/21/2001	Mary M. DaRif	6962	8619

7590 10/24/2003

The Sherwin-Williams Company  
Legal Dept.  
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EXAMINER

GREEN, BRIAN

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

10/026,041

Applicant(s)

DARIF ET AL.

Examiner

Brian K. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 5, and claim 10, line 7, there is no antecedent basis for “the entire surface area” and for “the area surrounding the detachable chip section”.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620) in view of Teter et al. (U.S. Patent No. 6,112,665).

Dohse shows in figures 1-3 a paint color card comprising chip sections that are coated with layers of colored compositions (the paint colors white, yellow, orange, etc.) and perforations for allowing each of the colored compositions to be separated from the card, see page 1, column 1, lines 41-43. Dohse does not disclose placing perforations on the card so that the colored coating covers both the surface of the chip and the area surrounding the chip section. Teter et al. shows in figures 4 and 5 the idea of placing perforations (14) within a colored section in order to allow the perforated area to be removed. In view of the teachings of Teter et al. it would have been obvious to one in the art to modify Dohse by adding an additional set of perforations to each of

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the colored coated compositions since this would allow an opening to be formed within the colored coated compositions which would allow better color matching to be performed, as taught by Teter et al., column 4, lines 55-65. In regard to claim 2, when the colored section B2 is removed from the card a window would be created. In regard to claims 3 and 13, Dohse discloses the applicant's basic inventive concept except for making the chip sections square. Dohse discloses the idea of making the chip sections rectangular. It would have been an obvious matter of design choice to make the chip sections square since the applicant fails to provide any advantage to making the sections square and the rectangular sections taught by Dohse would work equally well. In regard to claim 11, one of the sections, for example B2, could be separated along three sides and folded along the fourth side as defined.

Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620) in view of Teter et al. (U.S. Patent No. 6,112,665) as applied to claims 1 and 10 above and further in view of Spangler (U.S. Patent No. 6,270,123) or the applicant's admitted prior art on pages 1 and 2 of the specification.

Dohse in view of Teter et al. disclose the applicant's basic inventive concept except for making the color card out of paper. Dohse does not disclose what type of material is used to make the color card. Spangler discloses in column 6, lines 20-25 the idea of making a color card out of paper. The applicant discloses on page 1 that it is known to make color cards out of paper. In view of the teachings of Spangler or the applicant's admitted prior art it would have been obvious to one in the art to modify Dohse by making the color card out of paper since this would allow the card to be made in an easier and less expensive manner.

Claims 5-7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620) in view of Teter et al. (U.S. Patent No. 6,112,665) as applied to claims 1 and 10 above and further in view of Day et al. (U.S. Patent No. 4,104,809)

In regard to claim 5,6, and 15, Dohse discloses the idea of placing indicia on each chip section to indicate the color of the paint chip but does not disclose placing a formula for the paint color. Day et al. shows in figure 1 the idea of placing indicia for indicating the color of each chip section and indicia for indicating a code/formula for each chip section. In view of the teachings of Day et al. it would have been obvious to one in the art to place the paint formula/code on each of the paint chip sections since this would allow a person to make the desired colored paint in an easier and faster manner. In regard to claim 7, Dohse discloses on page 1, column 2, lines 15-25, the idea of placing a code on the back of each chip section. It would have been obvious to one in the art to modify Dohse by placing the paint formula on the back of each chip section since this would allow the entire color on each of the paint sections to be seen and not be partially obscured by the indicia written thereon.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620) in view of Teter et al. (U.S. Patent No. 6,112,665) as applied to claim 1 above and further in view of Edwards (U.S. Patent No. 4,992,050).

Dohse in view of Teter et al. disclose the applicant's basic inventive concept except for placing a color coating on the back of each chip section. Edwards discloses in the abstract the idea of placing a first color of paint on a first side of a chip section and a coating of paint on the

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opposite side of each chip section. Edwards discloses that the paint on the second side has a different finish as compared to the first side. In view of the teachings of Edwards it would have been obvious to one in the art to modify Dohse by placing a coat of paint on the second surface of each chip section since this would allow more colors/finishes to be displayed by the color card. In regard to claim 9, the colors on each side of the paint chip sections of Edwards are considered to be of the same color but would have different compositions. Further, as indicated above, placing a coat of paint on the second surface of each chip section would allow more colors to be displayed by the card, i.e. one color on the front of the card and a second color on the back of the card. Also, when different finishes are used the colors would be slightly different. In regard to claim 8, it is considered within one skilled in art to place the same color on the back of each chip section as on the front since this would allow the color of the paint to be seen on either side of the chip section, i.e. easier and quicker to determine the paint color shown by the color card.

### ***Response to Arguments***

Applicant's arguments filed Aug. 8, 2003 have been fully considered but some of the arguments are not persuasive.

The applicant argues that the color-display section of Dohse is framed by a non-colored area and therefore does not anticipate independent claims 1 and 10 as now amended. Dohse has been modified by the Teter et al. patent to add this additional limitation.

The applicant argues that the Dohse patent does not disclose making the colored section square. Dohse teaches the idea of making the colored section rectangular. The applicant fails to

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define any advantage to making the colored section square. It is therefore considered within one skilled in the art to make the colored section any shape as desired.

The applicant argues that the Day patent does not disclose the idea of placing the formula of the paint on the chip section. Day shows in figure 1 the idea of placing the paint color name, color no., card no., and additional codes. As is well known in the art, the color and other codes placed on the chip sections are used by the paint mixer to form the desired color of paint by punching the corresponding codes/color into the computer. The color and/or other codes in a sense are the formula since the color/codes and formulas correspond to one another. Further, the applicant's "formula" is merely as code as shown in figures 2,4, and 5.

The applicant argues that the Edwards patent does not teach the idea of making the second coating composition of a different color as compared to the first coating composition as defined in claim 9. Edwards teach that the colors on each side of the paint chip sections have a different finish. When different finishes are used the colors would be slightly different. Further, it is considered within one skilled in the art to make the colors on the front and the back of the card different since this would allow more colors to be displayed by the card as suggested in the 103 rejection of Dohse in view of Edwards.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-4177.

  
BRIAN K. GREEN  
PRIMARY EXAMINER

Bkg  
Oct. 23, 2003